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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,579	11/05/2003	Wayne Conrad	12811-363/PMdC	7597
1059	7590	09/27/2006		
BERESKIN AND PARR 40 KING STREET WEST BOX 401 TORONTO, ON M5H 3Y2 CANADA				
			EXAMINER TILL, TERRENCE R	
			ART UNIT 1744	PAPER NUMBER

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/700,579

Applicant(s)

CONRAD, WAYNE

Examiner

Terrence R. Till

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Objections

1. Claim 7 is objected to because of the following informalities: In claim 7, "the dirty air outlet" lacks antecedent basis. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Ferrari et al. (US-5,107,567).
4. The patent to Ferrari et al. discloses an upright surface cleaning apparatus comprising a surface cleaning head 14 and an upper casing 10,30,32 pivotally mounted thereto, the upper casing movable (via pivot 16) between a storage position in which the upper casing extends

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generally vertically upwardly from the surface cleaning head and an in use position, the surface cleaning head having a dirty air inlet 14a, a clean air outlet (wall of filter 24), an air flow passage 12,22 extending between the dirty air inlet and the clean air outlet, the air flow passage including a conduit 12 extending generally vertically upwardly when the upper casing is in the storage position and a motor and fan assembly 18,20 positioned in the conduit. Ferrari et al. also discloses the filtration member 24 positioned in the upper casing and the conduit extends between the surface cleaning head and the filtration member. The motor and fan assembly is considered to be positioned adjacent the surface cleaning head, the conduit is considered to have a longitudinal axis and the motor/fan assembly has an axial flow direction (see arrows) and is positioned in the conduit portion such that the axial flow direction is parallel and coplanar with the longitudinal axis of the conduit, the motor/fan assembly is positioned exterior to the surface cleaning head and the conduit extends away from the surface cleaning head (see figures 1 and 2).

5. Claims 1-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Stephens et al. (US-2002/0092123- cited in IDS).

6. The patent to Stephens et al. discloses an upright surface cleaning apparatus comprising a surface cleaning head 2 and an upper casing 4 pivotally mounted thereto, the upper casing movable (see paragraph 19) between a storage position in which the upper casing extends generally vertically upwardly from the surface cleaning head and an in use position, the surface cleaning head having a dirty air inlet 14, a clean air outlet 137, an air flow passage 12,46,58,128,142 extending between the dirty air inlet and the clean air outlet, the air flow passage including a conduit 142 extending generally vertically upwardly when the upper casing is in the storage position and a motor and fan assembly 112,116 positioned in the conduit.

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Stephens et al. also discloses a filtration member 60 positioned in the upper casing and the conduit extends between the surface cleaning head and the filtration member. The motor and fan assembly is considered to be positioned adjacent the surface cleaning head, the conduit is considered to have a longitudinal axis and the motor/fan assembly has an axial flow direction (see arrows 178) and is positioned in the conduit portion such that the axial flow direction is parallel and coplanar with the longitudinal axis of the conduit, the motor/fan assembly is positioned exterior to the surface cleaning head and the conduit extends away from the surface cleaning head (see figure 7). Stephens et al. additionally discloses the portion comprises two generally vertically extending air flow ducts, 38a or 38b, and 142 and a motor and fan assembly is provided in one of the generally vertically extending airflow ducts.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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9. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferrari et al. (US-5,107,567).

10. The patent to Ferrari et al. discloses all the claimed subject matter, including the motor/fan assembly having a linear extent and the portion of the airflow passage having a linear extent, but does not disclose the linear extent of the portion of the airflow passage being at least about three times, or five times, the linear extent of the motor/fan assembly. It would have been obvious to a person skilled in the art at the time the invention was made to modify the linear extent of the portion of the airflow passage of Ferrari et al. to be at least about three times, or five times, the linear extent of the motor/fan assembly as such is just a mere change in size of the component. *Gardner v. TEC systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984).

11. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stephens et al. (US-2002/0092123- cited in IDS).

12. The patent to Stephens et al. discloses all the claimed subject matter, including the motor/fan assembly having a linear extent and the portion of the airflow passage having a linear extent, but does not disclose the linear extent of the portion of the airflow passage being at least about three times, or five times, the linear extent of the motor/fan assembly. It would have been obvious to a person skilled in the art at the time the invention was made to modify the linear extent of the portion of the airflow passage of Stephens et al. to be at least about three times, or five times, the linear extent of the motor/fan assembly as such is just a mere change in size of the component. *Gardner v. TEC systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984).

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Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents to Hawkins et al., Sepke, Sepke et al., Dyson, Nerheim and Smith disclose typical vacuum cleaner arrangements having one or more features of the claimed invention. The patents to Schiazza et al., Leung and Tyler disclose battery powered upright vacuum cleaners. The European application to Oreck and UK application to Edginton are cited as applicant did not provide copies of the foreign documents for the IDS filed 11/2/04.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Terrence R. Till whose telephone number is (571) 272-1280. The examiner can normally be reached on Mon. through Thurs. and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gladys P. Corcoran can be reached on (571) 272-1214. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Terrence R. Till
Primary Examiner
Art Unit 1744

trt